



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,788	11/20/2001	Teruhiro Shiono	2001_1700A	9136

513 7590 11/15/2005

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/988,788

Applicant(s)

SHIONO ET AL.

Examiner

Peter Vincent Agustin

Art Unit

2652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


BRIAN E. MILLER
PRIMARY EXAMINER

Application/Control Number: 09/988,788

Page 2

Art Unit: 2652

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicant's arguments filed October 26, 2005 have been fully considered but they are not persuasive.

The Applicant traverses the rejection of claims 17, 22, 24, 25, 29 & 31 because the Kawada et al. reference allegedly fails to disclose or suggest the feature of claim 17 that "the amount of change in refractive index is less than or equal to 0.02".

In the previous Office Action, the Examiner noted that Kawada et al. teach this feature. Paragraph 13 of Kawada et al. teaches a refractive index change of $1 \mu\text{m}^3$, which has a numerical value of 0.000001 (which clearly satisfies the claimed "less than or equal to 0.02") and a unit of m^3 (cubic meters). In addition, for the sake of Applicant's previously set forth arguments that the Kawada et al. reference teaches a range of 1mm^3 , the Examiner also noted that Kawada et al. still anticipate the claimed "less than or equal to 0.02" because 1mm^3 is actually 0.001, which is less than 0.02.

The Applicant's traversal is mostly based on arguments that Kawada et al. teach a "volume measurement". For example, the Applicant argues on page 3, paragraph 2 that "Applicants note the Examiner is mistaken in stating that 1mm^3 is equal to 1×10^{-3} or 0.001" because " 1mm^3 is a volume measurement, i.e., a cubic millimeter, and in no way whatsoever is equal to 1×10^{-3} ." This argument is not persuasive. It is irrelevant that Kawada et al. teach a unit of volume because the Applicant does not claim a specific unit of measurement. The refractive index change of Kawada et al. has a numerical value that anticipates the claimed range regardless of the unit of measurement.

Furthermore, the Applicant notes that "refractive index is generally expressed without units (i.e., no dimensions), whereas 1mm^3 or $1\mu\text{m}^3$ clearly includes a unit measurement" (see page 4, lines 1-2). This is not found persuasive. Regardless of the fact that Kawada et al. teach a unit measurement of mm^3 or μm^3 , paragraph 13 clearly teaches that this is a "refractive-index change".

For at least these reasons, the Examiner maintains the rejection of claims 17-29 & 31.